

Remarks:

Claims 1, 2, 4-6, 8, and 16-20 are pending. Applicant has amended the claims to distinctively claim the subject matter of the invention. By virtue of this amendment, claims 1, 2, 8, 16, and 17 are amended. New claim 21 is added. No new matter is added as support for the amendments is found within the Specification and the drawings. It is submitted that the application, as amended, is in condition for allowance.

§Objection(s):

Claims 1 and 16 are objected to for reciting the term “for.” The term “for” has been removed from claims 1 and 16.

The Specification is objected to for failing to provide proper antecedent basis for the claimed subject matter as recited in claims 1 and 16. Please see the remarks below with respect to the §112 rejection.

§101 Rejection(s):

Claim 16 is rejected under 35 U.S.C. §101 for being directed to non-statutory subject matter, particularly “logic units.” Claim 16 has been amended to no longer recite “logic units.”

§112 Rejection(s):

Claims 1 and 16 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. This rejection is moot in view of the amendments to claims 1 and 16.

The Examiner is reminded that §112, first paragraph, requires for the Specification to adequately support the subject matter claimed rather than mirroring the claim language word for word. MPEP §2163, *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306,

1319, 66 USPQ2d 1429, 1438 (Fed. Cir. 2003); *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d at 1563, 19 USPQ2d at 1116.

Support can be provided “in a variety of ways” and “using such descriptive means as words, structures, figures, diagrams, and formulas” to “show that the applicant was in possession of the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). See, e.g., *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 68, 119 S.Ct. 304, 312, 48 USPQ2d 1641, 1647 (1998).

Further, claim limitations may be supported in the Specification through “express, implicit, or inherent disclosure.” See *In re Oda*, 443 F.2d 1200, 170 USPQ 268 (CCPA 1971). Contrary to the Examiner’s understanding, section §112, first paragraph does not require a word-for-word matching between the language in the specification and the language recited in the claims. If one were to interpret §112, first paragraph, according to the Examiner’s understanding, then the claim language would have to be limited to identical language used in the specification and nothing more.

Referring to MPEP 2163 (II) (A), “[t]he examiner has the initial burden, after a thorough reading and evaluation of the content of the application, of presenting evidence or reasons why a person skilled in the art would not recognize that the written description of the invention provides support for the claims. There is a strong presumption that an adequate written description of the claimed invention is present in the specification as filed, *Wertheim*, 541 F.2d at 262, 191 USPQ at 96.”

§103 Rejection(s):

Claims 1, 2, 4, 16, 17, and 18 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent no. 6,980,660 to Hind (hereafter “Hind”) as modified by the Examiner. Claims 5, 6, 8, 19, and 20 are rejected under 35 U.S.C. §103(a) as being

unpatentable over Hind et al. in view of U.S. Patent No. 6,075,860 to Ketcham (hereafter "Ketcham"). These rejections are respectfully traversed.

Hind fails to teach or suggest all of the elements recited in claim 1, as amended. In particular, Hind fails to teach or suggest a server system 1) receiving a request from the mobile device to provide a unique security key; 2) generating a unique security key, in response to receiving the request from the mobile device; 3) receiving a request from the service provider to provide the unique security key, wherein the service provider requests the unique security key in order to establish a secure communication session with the mobile device; and 4) providing the unique security key to the service provider, in response to determining that the service provider is included in a list of approved service providers, 5) wherein the list of approved service providers is updatable by the mobile device, and 6) wherein the secure communication session is established between the service provider and the mobile device, in response to the service provider presenting the unique security key to the mobile device for authentication.

In fact, Hind directly teaches away from the above elements. That is, Hind teaches generation of two security keys, a private key and a public key, while claim 1 recites generation of a unique security key. See column 8, lines 62-64; column 9, lines 30-32. For this reason alone, Hind teaches away from claim 1 and should be withdrawn for being an improper reference.

Hind also teaches that generation of the two security keys is initiated by administration server 1001 requesting an identifier from the mobile device 1003. See column 8, lines 59-64; column 9, lines 14-32. Claim 1, however, recites that generation of the unique security key is initiated by the mobile device requesting the unique security key from the server system. Generation of the two security keys in Hind is initiated by the server system, while generation of the unique security key in claim 1 is initiated by the mobile device. In addition, the request in Hind is for an identifier of the mobile

device, while the request in claim 1 is for the unique security key. Accordingly, since Hind teaches away from claim 1, Hind should be withdrawn for being an improper reference.

Further, Hind teaches that the first device 2003 (service provider) sends a connection request to the second device 2001 (mobile device), in order to establish a communication session with the second device 2001 (mobile device). See column 11, lines 13-16. Claim 1, however, recites that the service provider requests the unique security key from the server system, in order to establish a communication session with the mobile device. The request in Hind is sent to the mobile device, while the request in claim 1 is sent to the server system. In addition, the request in Hind is a connection request, while the request in claim 1 is a request for the unique security key. Accordingly, since Hind teaches away from claim 1, Hind should be withdrawn for being an improper reference.

Moreover, Hind teaches two-way authentication between the first device 2003 (service provider) and the second device 2001 (mobile device). See column 24-38. Claim 1, however, recites that the secure communication session is established between the service provider and the mobile device, in response to the service provider presenting the unique security key to the mobile device for authentication. Thus, Hind teaches two-way authentication, while claim 1 recites one-way authentication. Accordingly, since Hind teaches away from claim 1, Hind should be withdrawn for being an improper reference.

The Examiner on page 9 of the Office Action contends that it would have been obvious to modify Hind to include a list of service providers in the optional data portion of a certificate. Respectfully, the modification proposed by the Examiner is impermissible hindsight reconstruction given the benefit of Applicant's disclosure. Reliance on impermissible hindsight to avoid express limitations in the claims and setting

forth unsupported hypothetical teachings to recreate the Applicant's claimed invention cannot establish a *prima facie* case of obviousness. Regardless, Hind fails to teach or suggest that the list of service providers is updatable by the mobile device, as recited in claim 1.

Since Hind teaches away from the claim 1, a person of ordinary skill in the art could not be motivated to combine Hind with any other reference as the result would also teach away from claim 1.

Even assuming, *arguendo*, that the Hind could be combined with Ketcham, Ketcham fails to cure the deficiencies of Hind with respect to claim 1. In particular, Ketcham fails to teach or suggest a server system 1) receiving a request from the mobile device to provide a unique security key; 2) generating a unique security key, in response to receiving the request from the mobile device; 3) receiving a request from the service provider to provide the unique security key, wherein the service provider requests the unique security key in order to establish a secure communication session with the mobile device; and 4) providing the unique security key to the service provider, in response to determining that the service provider is included in a list of approved service providers, 5) wherein the list of approved service providers is updatable by the mobile device, and 6) wherein the secure communication session is established between the service provider and the mobile device, in response to the service provider presenting the unique security key to the mobile device for authentication.

Further, while the suggestion to modify or combine references may come from the knowledge and common sense of a person of ordinary skill in the art, the fact that such knowledge may have been within the province of the ordinary artisan does not in and of itself make it so, absent clear and convincing evidence of such knowledge. *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ 2d 1225, 1232 (Fed. Cir. 1998).

Here, the modification or combination proposed by the Examiner is not based on any clear and convincing evidence of a reason, suggestion, or motivation in the prior art that would have led one of ordinary skill in the art to combine the references. Rather, the reason, suggestion and motivation for the combination of references proposed by the Examiner simply is impermissible hindsight reconstruction given the benefit of Applicant's disclosure.

The Federal Circuit has consistently held that hindsight reconstruction does not constitute a *prima facie* case of obviousness under 35 U.S.C. §103. *In re Geiger*, 2 USPQ 2d 1276 (Fed Cir. 1987). Unfortunately, the Examiner rather than pointing to what the prior art discloses and teaches as to making the suggested modification relies on assumptions and statements without any support in the record. As such, the Examiner's statements regarding obviousness and motivation to modify are but shortcuts to a conclusion of obviousness devoid of the required analytical approach based on what is actually disclosed in the prior art.

Reliance on impermissible hindsight to avoid express limitations in the claims and setting forth unsupported hypothetical teachings to recreate the Applicant's claimed invention cannot establish a *prima facie* case of obviousness. Since obviousness may not be established by hindsight reconstruction, Applicant invites the Examiner to point out the alleged motivation to combine with specificity,¹ or alternatively provide a reference or affidavit in support thereof, pursuant to MPEP §2144.03.²

¹ *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

² "The rationale supporting an obviousness rejection may be based on common knowledge in the art or "well-known" prior art . . . If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position. When a rejection is based on facts within the personal knowledge of the examiner . . . the facts must be supported, when called for by the applicant, by an affidavit from the examiner."

Since no reasonable justification is provided in the Office Action as to how such modification or combination is possible and obviousness may not be established based on hindsight and conjecture, it is respectfully requested that the §103 rejections be withdrawn.

For the above reasons, none of the cited references, either alone or in combination, teach or suggest all the elements recited in claim 1. Therefore, it is respectfully submitted that claim 1 is in condition for allowance. Claims 2, 4-6, and 8 depend on claim 1 and should be in condition for allowance by virtue of their dependence on an allowable base claim. Claim 16 substantially incorporates the elements of claim 1; therefore, claim 16 and claims 17-21 depending from claim 16 should also be in condition for allowance.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has expressly argued herein that such amendment was made to distinguish over a particular reference or combination of references.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California, telephone number (888) 789 2266 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

/F. Jason Far-hadian/

Date: December 18, 2008

By:

F. Jason Far-hadian, Esq.
Registration No. 42,523